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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,749	10/22/2001	Noboru Asauchi	Q66728	8429

7590 03/29/2005

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,749

Applicant(s)

ASAUCHI ET AL.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) NONE is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-29 is/are allowed.
- 6) ☒ Claim(s) 1,2,9-11,18-22 and 30-33 is/are rejected.
- 7) ☒ Claim(s) 3-8 and 12-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/14/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119 is acknowledged.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

3. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

3.1 Claims 20-22 & 30-33 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

3.1.1 The instant claims recite a system/device/manufacture, (claims 20-22 & 30-33), which has a disclosed practical application in the technological or useful arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device/manufacture that contains a data structure comprising series of steps or acts or functions or operations that as claimed could be but are not necessarily to be performed by a computer.

3.1.2 It is further noted that applicant has not recited a specific machine since the steps or acts or functions or operations recited in the claim are merely to illustrate the steps or acts or functions or operations of the instant invention since these steps or acts or functions or operations as claimed are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claims 20-22 & 30-33 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

3.1.3 In view of the above, the invention recited in claims 20-22 & 30-33, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 20-22 & 30-33 do not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

3.1.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

3.1.5 Hence, claims 20-22 & 30-33 are directed to non-statutory subject matter.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.1 Claims 1, 2, 9-11 & 18-20 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Farrell (5,383,129).

4.1.1 In regard to claims 1, 2, 10, 11, 19 & 20, Farrell ('129) discloses a computer implemented system which under the control of an operating program stored in the system's memory receives a request for a price concerning a job that would use an estimated amount of expendable materials. The estimated amount of expendable materials is then used to determine the price for the expendable materials that are to be removed from containers mounted in the system of Farrell ('129) and hence the price for the print job. The determined price is then displayed to the user. This process is repeated for each job to be estimated.

4.1.2 In regard to claims 9 & 18 and the price being related to the amount of new expendable material, since after each job, the expended materials must be replaced for continued operation, it would have been inherent to one of ordinary skill that the amount of replacement expendable materials would equal the amount of expendable materials used in the print job.

5. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) in regard to claims 3 & 12, the prior art does not teach or suggest including information concerning the remaining amount of an expendable in the determination of the price of the replacement of the expendable. Claims 4 & 13 is allowable for the same reason.

B) in regard to claims 5 & 14, the prior art does not teach or suggest including a memory on an container of expendable material, where the memory contains information concerning the expendable.

C) in regard to claims 6, 15, 21, 23 & 30, the prior art does not teach or suggest including information regard whether or not the replaced container of the

Art Unit: 3629

expendable material is to be returned to the supplier of the replacement of the expendable when determining the price of the replacement of the expendable material. Claims 7-8, 16-17, 22, 24-29 & 31-33 are allowable for the same reason.

6. The examiner has cited prior art of interest, for example:

A) Storace (4,811,234) which discloses monitoring the time rate of change in a consumable value in response to a request.

B) Aizawa (JP 02-84677) discloses the monitoring of expendable materials in a printing process so that the toner/ink is replenished in time to maintain an uniform density.

C) Higgins (4,961,507) which discloses monitoring the rate or use of a number of consumable items.

D) either Froger et al (6,089,688) or Uozumi et al (WO 92/18335) which disclose monitoring the use of ink so as to determining the remaining supply of ink.

7. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

Art Unit: 3629


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

8.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

8.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/20/05


Edward R. Cosimano
Primary Examiner A.U. 3629